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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DARYL L. CHAMPAGNE and DON G. BARTKOWIAK

Appeal 2009-000452
Application 09/543,686
Technology Center 3600

Decided:¹ May 29, 2009

Before, ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

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STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-44. We have jurisdiction under 35 U.S.C. § 6(b). (2002)

SUMMARY OF DECISION

We AFFIRM IN PART.

THE INVENTION

Appellants claim an online system and method of ordering and specifying consumer product having specific configurations (Spec. 1:4-6).

Claims 1 and 21, reproduced below, are representative of the subject matter on appeal.

1. An online method of ordering and purchasing customized products, comprising:
 - receiving a custom order message incorporating order data and product configuration data submitted by an online user;
 - storing the order data and product configuration into a buyer database;
 - entering the custom order and order data and product configuration into an order bank to be scheduled for manufacturing;
 - cancelling the custom order after processing of the custom order is initiated and before the custom order is scheduled for manufacturing if a cancel request is received from the user; and
 - generating an order confirmation message and sending the order confirmation message to the user.
21. An online custom product ordering and purchasing system, comprising:
 - an online user interface operable to provide product configuration and to receive an online order for a product having a specific product configuration;
 - a web server operable to receive the online order from the online user interface;

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an order processor operable to:

receive the online order from the web server and process the order; and generate an order confirmation message and send the order confirmation message to a user; and

an order bank operable to:

store online order and schedule a product having the product configuration specified in the online order for manufacturing; and

cancel the custom order after processing of the custom order is initiated and before the custom order is scheduled for manufacturing if a cancel request is received from the user.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Green	6,041,310	Mar. 21, 2000
Henson	6,167,383	Dec. 26, 2000

“e-Parcel Delivers Data for Toyota’s Production Control Division,” Business/Technology/Automotive Writers, Business Wire, New York, June 1, 1999, p. 1. (PTO-892, Ref W).

“Can Car-Makers Emulate Dell? Toyota Tries,” Jeffrey Bodenstab, Wall Street Journal, Brussels, August 31, 1999, p. 10. (PTO-892, Ref V).

“Customers Move into the Driver’s Seat: Personalized products become viable with the net,” Otis Port, Business Week, New York, October 4, 1999, Issue 3649, p. 103. (PTO-892, Ref X).

“Push is on shorten lead-times for custom car orders,” Brian Milligan, Purchasing, Boston, October 7, 1999, Vol. 127, Iss. 5, p. 74. (PTO-892, Ref U).

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The following rejections are before us for review.

The Examiner rejected claims 1-6, 13-31, and 39-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over a public use or knowledge of Toyota in view of Henson.

The Examiner rejected claims 7-12 and 32-38 under 35 U.S.C. § 103(a) as being unpatentable over a public use of Toyota in view of Henson, in further view of Green.

ISSUE

Have Appellants shown that the Examiner erred in rejecting claims 1-6, 13-31, and 39-44 on appeal as being unpatentable under 35 U.S.C. § 103(a) over Toyota in view of Hanson on the grounds that a person with ordinary skill in the art would understand that the combination meets the claim language of canceling the custom order after processing of the custom order is initiated, and before the custom order is scheduled for manufacturing, if a canceled request is received from the user.

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. The Examiner rejected claims 1-6, 13-31, and 39-44 under 35 U.S.C. § 103(a) unpatentable over either public use or knowledge of Toyota in view of Henson. (Final p. 4).
2. The Examiner found that Toyota Article U discloses:
[c]anceling the custom order after processing of the

custom order is initiated and before the custom order is scheduled for manufacturing if a cancel request is received from the user (Toyota, Page 1: "The problem now is with last minute changes, whereby a supplier gets a production order and then it is changed... It happens quite frequently now."). (Ans. 5).

3. The Examiner further found with respect to the claim language reciting "cancel the custom order after processing of the custom order is initiated and before the custom order is scheduled for manufacturing if a cancel request is received from the user" that:

the canceling language does not positively recite an action step, it only denotes a situation wherein a product may be cancelable if a relevant party involved in the transaction is not satisfied with the particular order. The limitation, "Canceling the custom order after processing of the custom order is initiated and before the custom order is scheduled for manufacturing if a cancel request is received from the user." is a conditional limitation.... In claims, once the positively recited portions are satisfied, the claim as a whole is satisfied -- regardless of whether or not other portions are conditionally invocable (sic) under certain other hypothetical scenarios (sic).

(Ans. 14).

4. The Examiner found that Toyota fails to expressly disclose:
... an online method of ordering and purchasing customized products, comprising:
 - Storing the order data and product configuration into a buyer database; and
 - Generating an order confirmation message and sending the order confirmation message to the user.

Henson discloses an online method of ordering and

purchasing customized products, comprising-

- Storing the order data and product configuration into a buyer database (Figure 1, "Database 24"); and
- Generating an order confirmation message and sending the order confirmation message to the user (Figure 1, =THANK YOU" and col. 5, ll. 23-27). (Ans. 5, 6).

5. The Examiner found that

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method of Toyota to have included the limitations found in the method of Henson in order to have solved problems that existed in previous generation online stores including a lack of responsiveness to customer requests and an incompleteness of information delivery (column 2, lines 48- 58). Furthermore, Henson is assigned to *Dell* and discloses a method and apparatus for providing customer configured machines at an Internet site. PTO-892, Ref U, explicitly discloses that Toyota is trying to emulate *Dell's* business model of delivering personal products to order. (Ans. 6).

6. The Examiner found with respect to Toyota Article X, that Article X discloses:

[r]eceiving a custom order message incorporating order data and product configuration data submitted by an online user (Toyota, Page 12: Customers would pick and choose from a menu of onscreen options, then hit a button to send the order straight to the factory. Toyota has been equipping showrooms in Japan with Internet terminals since 1995.").... (Ans. 5).

7. The Examiner found that the publication dates of each of Articles U, V,

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W, and X predate the provisional filing date of the present application as follows:

...the instant application claims benefit to a provisional application filed 11/05/1999. Ref U has a publication date of 10/07/1999, Ref V has a publication date of 8/31/1999, Ref W has a publication date of 6/01/1999, and Ref X has a publication date of 10/04/1999. (Ans. 5)

8. The Specification describes the order bank as:

Order process 644 receives an order number from a vehicle order application 1150, which typically resides at a web site, portal or is part of the portal.... Order process 644 places the order into the enterprise ordering system 1158, which resides on the enterprise mainframes.
(Specification 39: 20-27)

PRINCIPLES OF LAW

The mere fact that a disclosure is contained in a patent or application and thus ‘constructively’ reduced to practice, or that it is found in a printed publication, does not make the disclosure itself any more meaningful to those skilled in the art (and thus, ultimately, to the public). Rather, the criterion should be whether the disclosure is sufficient to enable one skilled in the art to reduce the disclosed invention to practice. In other words, the disclosure must be such as will give possession of the invention to the person of ordinary skill. Even the act of publication or the fiction of constructive reduction to practice will not suffice if the disclosure does not meet this standard. *Application of Borst*, 345 F.2d 851 (CCPA, 1965) citing *In re Sheppard* and *In re LeGrice*.

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“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

ANALYSIS

We affirm the rejection of claims 1-20, 26-44, and reverse as to claims 21-25. The Appellants do not provide a substantive argument as to the separate patentability of claims 2-20, and 27-44 that depend from claims 1 and 26 respectively, which are the sole independent claims among those claims. Therefore, regarding the claims whose rejection is affirmed, we address only claims 1 and 26. Claims 2-20, and 27-44 fall with claims 1 and 26.

Preliminarily, we begin by noting that the rejection made by the Examiner is based on 35 U.S.C. § 102 (a) using either public use or knowledge of Toyota (FF 1). In reviewing the record, we note that the Examiner was less than precise in how the rejection was formulated and we understand the rejection to be over the

knowledge and practices as evidenced by Toyota, rather than public use. We thus address Toyota as references based on public knowledge and/or printed publications documenting Toyota's planned production practices known to the public rather than evidence of public use. Thus, each reference is evidence of part of the whole of the production practices the rejection is based on. In order for the Toyota to qualify as a reference(s) under 35 U.S.C. § 102 (a), the involved disclosures must be such as will give possession of the invention to the person of ordinary skill. *See Application of Borst, 345 F.2d 851 (CCPA, 1965).*

Appellants challenge the Examiner's use of four articles, marked U, V, W and X, which the Examiner has grouped together under the collective title of, "Toyota", in rejecting the claims under 35 U.S.C. § 102 (a) (Ans. 2, 3). Regarding the items marked as U, V and X², Appellants argue that because each of these references discusses the involved claimed features in the future tense using the word "will", they should be removed as references because of "...the unspecified nature and timing of the functionality disclosed by the articles." (App. Br. 7). However, insomuch as we review articles U, V and X as evidence of public knowledge and/or printed publications rather than public use, we disagree with Appellants because the future tense aspect of the content of the disclosures while it goes to evidence of public use, nevertheless does not diminish whether what is disclosed gives possession of the invention to the person of ordinary skill.

² The Examiner in his final rejection does not use Article W in rejecting the claims, thus we exclude it from our analysis.

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Appellants challenge the finding by the Examiner that the publication dates of the Toyota articles U, V, W, and X predate its application's effective filing date so as to constitute a reference under 35 U.S.C. § 102 (a) based on public use. (App. Br. 7). We disagree with Appellants because as found *supra* (FF 7), the dates established by the Examiner for Articles U, V, W and X each predate the effective filing date of this application (FF 7) - this is not contested. Since our analysis is based on our use of Articles U, V, W and X as evidence of public knowledge and/or as printed publications rather than use, the publication dates establish the articles as valid references evidencing knowledge, and/or as printed publications of disclosed features.

With respect to what is disclosed in each of the articles U, V and X, Appellants argue that these articles fail to teach, suggest, or disclose various aspects of the rejected claims, particularly, that each is deficient in at least two limitations of the claims, namely: *storing the order data and product configuration into a buyer database and generating an order confirmation message and sending the order confirmation message to the user.* (App. Br. 8). That argument is not well taken because Appellants are attacking the Toyota references individually when the rejection is based on a combination of references and the Examiner found that Henson and not Toyota discloses the missing features (FF 4,5). *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Young*, 403 F.2d 754, 757-58 (CCPA 1968).

Appellants more specifically argue that

[t]he author of Ref X makes a passing comment that "General Motors Corp. and Ford Motor Co. will soon

join Toyota Motor Corp. in giving the same power to car buyers." Toyota, page 11. The power referred to is "buyers... tailor[ing] products the way they want them." Id. The periodical does not articulate the functionality underlying the Toyota process. (App. Br. 7).

We disagree with Appellants because the Examiner relies on Article X as evidence of public knowledge for exactly what is being disclosed in it, namely, receiving a custom order message incorporating order data and product configuration data submitted by an online user (FF 6). That is, Article X discloses that customers would pick and choose from a menu of onscreen options, then hit a button to send the order straight to the factory. Article X goes on to disclose, Toyota has been equipping showrooms in Japan with Internet terminals since 1995. (FF 6). Appellants' argument is thus not persuasive as to error in the rejection because Article X does expressly articulate the underlying functionality of the process.

Appellants next argue:

[t]he Examiner has also failed to provide evidence that the alleged Toyota public use provides for "canceling the custom order processing of the custom order is initiated and before the custom order is scheduled for manufacturing if a cancel request is received from the user," as recited in claim 1. (App. Br. 8).

The Examiner however maintains that Toyota Article U discloses the canceling feature in that it states: "[t]he problem now is with last minute changes, whereby a supplier gets a production order and then it is changed... It happens quite frequently now." (FF 2). We disagree with the Examiner that Toyota Article U is sufficient to give possession of the invention to the person of ordinary skill to

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the extent a person with ordinary skill in the art would derive from the disclosed problem the feature of canceling the custom order after processing of the custom order is initiated and before the custom order is scheduled for manufacturing if a cancel request is received from the user.

With this understanding we turn to the claims. Each of independent claims 1, 21 and 26 recites in a related form the limitation of: *cancel the custom order after processing of the custom order is initiated and before the custom order is scheduled for manufacturing if a cancel request is received from the user*. The Examiner found that this language constitutes a conditional limitation which is not required by the claims until the condition is met. (FF 3). We agree with the Examiner with respect to the method claims 1 and 26. That is, even though neither Toyota or Henson disclose a process which covers the canceling language, the claims present these steps as conditional limitations as part of a process not requiring structure to effect cancellation (FF 3) nor prescribing action unless and until the condition is met. Thus, the process offers two modes which can alternatively be met by the prior art ordering process namely, one having either a cancel or a non-cancel mode.

However, our conclusion is different for the system claim 21 because it requires structure in order to carry out the required action even though conditional. Such structure is claimed as an *order bank*, which according to the Specification, includes a mainframe (FF 8) which must have programming, e.g. structure to be capable of carrying out the involved canceling action regardless of whether the condition is or is not met.

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Regarding the rejection of claims 7-12 and 32-38 under 35 U.S.C. § 103(a) over the combination of Toyota, Henson, and Green, Appellants merely reassert the arguments made in challenging the rejection of claims 1-6, 13-31, and 39-44 under 35 U.S.C. § 103(a) as being unpatentable over a public use or knowledge of Toyota in view of Henson. (Appeal Br. 9, 10). Therefore for the reasons set forth above, we likewise sustain the rejection of claims 7-12 and 32-38.

CONCLUSIONS OF LAW

We conclude the Appellants have not shown that the Examiner erred in rejecting claims 1-20, 26-44 under 35 U.S.C. § 103(a), and have shown that the Examiner erred in rejecting claims 21-25 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 1-20, 26-44 is affirmed.

The decision of the Examiner to reject claims 21-25 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED IN PART

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